

Patricia Lewis
#13/req for

Attorney Docket No. PD-980142
Customer No. 020091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Arsenault et al.) I hereby certify that this paper
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U.S. Serial) with the United States Postal
No. : 09/492,725) Service as first class mail in an
envelope addressed to:
Filed : January 27, 2000) Mail Stop Appeal Brief-Patents,
Commissioner of Patents, P.O.
Title : A System and) Box 1450, Alexandria, VA 22313-
Method for) 1450 on this date:
Transmitting,)
Receiving and)
Displaying)
Advertisements)
Dated: August 18, 2003
Art Unit : 3622)
Examiner : Jean D. Janvier) *Georgeann S. Grunert*
GEORGEANN S. GRUNERT

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Brief
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REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer dated June 18, 2003 in connection with the above-referenced patent application, the applicants respectfully submit this Reply Brief in accordance with 37 C.F.R. 1.193.

I. Introduction

The examiner has ignored some of the most fundamental principles of U.S. patent law. In particular, the examiner's failure to interpret a term as used within its context continues in the Examiner's Answer. Further, the examiner continues to rely on a theory of inherency to support his position, but

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does so without any factual basis or line of technical reasoning as required by law.

II. Summary of the Invention

There can be no better summary of the invention than the claims at issue. Claims, after all, define the invention. Thus, the applicants' summary is, in fact, an accurate and concise explanation of the invention at issue as required by 37 C.F.R. § 1.192(c)(5).

III. Examiner's Response to Arguments

Once again, the examiner has failed to interpret the terms of claims 18-47 in light of the specification as is always required. *See U.S. v. Adams*, 178 USPQ 479, 482 (1966) (“[C]laims are to be construed in the light of the specification and both are to be read with a view to ascertaining the invention.”); *Autogiro Co. of America v. U.S.*, 384 F.2d 391, 397-98 (Ct. Cl. 1967) (“The use of the specification as a concordance for the claim is accepted by almost every court, and is a basic concept of patent law.”); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (in banc), *aff'd* 517 U.S. 370 (1996).

In the Examiner's Answer, the examiner accuses the applicants of improperly redefining or altering the common meaning of the terms “advertising object” and “image object.” The examiner's baseless accusation makes it clear that he has failed to recognize that a word or term can have multiple common meanings and that the common meaning of the term employed in a claim is that meaning which is consistent with the specification

and the claim language itself. *See Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203 (Fed. Cir. 2002) (“Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record *must always* be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.”) (emphasis added and citations omitted).

To illustrate the point, consider the meaning of the term “slew rate”: does the term “slew rate” mean the rate at which violent killing occurs or instead the fastest rate at which the output of an amplifier can change? Clearly, the meaning of a claim term cannot be divorced from its context (i.e., the claims and specification associated therewith). As another example, the word “frame” may be used in the context of either a picture frame or a data frame. Thus, the word “frame” has at least two common meanings, namely, a border surrounding a picture, or a segment of data generally including a header with preamble, destination and source addresses, and data payload. Likewise, the word “object” has at least two common meanings and, thus, depending on the context in which the word “object” is used, an object may be defined as either a construct containing data and methods (i.e., functions for manipulating the data), or a thing that can be seen or touched.

In this case, it is clear that the common meaning of the terms “advertising object” and “image object” being asserted by the applicants¹ is consistent with the meaning set forth in the specification. *See* U.S. Patent Application Serial No. 09/492,725, page 13, line 20 to page 19, line 15. On the other hand, the examiner’s asserted meaning of these terms is completely inconsistent with the specification. Under the examiner’s asserted meaning, advertising objects and image objects are video images, shapes, etc. that are visually perceived or viewed by a human. Thus, the only way in which the examiner’s asserted common meaning for the terms “advertising object” and “image object” could be reconciled with the specification at hand would require the bizarre conclusion that visually displayed shapes are the same as data structures, which is certainly not the case. *See* Examiner’s Answer, page 14, lines 15-16.

While the examiner appears to believe that he is being asked to commit one of the cardinal sins of patent law by reading limitations from the specification into the claimed invention, he is merely being asked to follow one of the most basic concepts of patent law by interpreting the terms “advertising object” and “image object” of the claims at issue in light of the specification. *See* Examiner’s Answer, page 15, lines 13-15.

Moreover, the Examiner’s answer fails to recognize that while words used in the claims are presumed to have their ordinary meaning as understood by one of ordinary skill in the art, it has been well established in patent law

¹ “Advertising object” and “image object” refer to digital data structures that may be linked to one another and that may be used to generate video images.

that a patentee is free to be his or her own lexicographer. *See Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14 (Fed. Cir. 2000) (“We acknowledge [the] assertion that a patentee is free to be his own lexicographer, and may define claim terms in ways that differ from the common understanding of those skilled in the art.”); *Markman*, 52 F.3d at 979 (“As we [Federal Circuit] have often stated, a patentee is free to be his own lexicographer.”); *Hormone Research Foundation, Inc. v. Genentech, Inc.*, 904 F.2d 1558 (Fed. Cir. 1990) (“It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer”); *see also Texas Digital Systems, Inc.*, 308 F.3d at 1204 (“[T]he presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning.”). Accordingly, the applicants may give a special meaning to a word, and define the word in the specification. *See Markman*, 52 F.3d at 979 (“[T]he description may act as a sort of dictionary, which explains the invention and may *define terms used in the claims*.”) (emphasis added).

Although the Federal Circuit has cautioned against reading additional limitations from the specification into the claims, it has repeatedly emphasized that “[c]laims must be read in view of the specification, of which they are a part.” *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1340 (Fed. Cir. 2001) (quoting *Markman*, 52 F.3d at 979). “[C]laims are not interpreted in a vacuum, but are part of, and are read in light

of, the specification.” *SciMed*, 242 F.3d at 1341; *see Teleflex, Inc., v. Ficosa North America Corp.*, 299 F.3d 1313, 1325-26 (Fed. Cir. 2002) (“The words used in the claims are interpreted in light of the intrinsic evidence of record, including the written description, the drawings, and the prosecution history, if in evidence. The intrinsic evidence may provide context and clarification about the meaning of claim terms. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.”) (internal quotations and citations omitted).

Even where the meaning of a claim term appears clear and unambiguous, the specification must always be consulted. *Watts v. XL Sys.*, 232 F.3d 877, 883 (Fed. Cir. 2000) (even if the claim terms were clear on their face, the court “must consult the specification.”) As the Federal Circuit has observed:

The role of the specification includes presenting a description of the technologic subject matter of the invention, while the role of claims is to point out with particularity the subject matter that is patented. The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose.

Network, LLC v. Centraal Corp., 242 F.3d 1347, 1352 (Fed. Cir. 2001). Ordinarily, the meaning assigned to a claim term should align with the purpose of the patented invention. *Apple Computer, Inc.*, 234 F.3d at 25; *Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc.*, 222 F.3d 951, 956 (Fed. Cir. 2000).

Even if the examiner refuses to accept the applicants' asserted common meaning for the terms "advertising object" and "image object" for the reasons set forth above, the applicants are free to be their own lexicographers.

Accordingly, the applicants are free to define the terms "advertising object" and "image object" as digital data structures composed of characterizing data elements, some of which may be used to link to advertising objects and image objects, as long as the terms are clearly defined in the specification.

In this case, the applicants have clearly defined the terms "advertising object" and "image object" in the specification. *See* U.S. Patent Application Serial No. 09/492,725, page 8, lines 4-5; page 13, line 20 to page 19, line 15; and page 19, line 25 to page 23, line 25. Contrary to the examiner's belief, he is not being asked to commit one of the cardinal sins of patent law by reading limitations from the specification into the claims. The examiner is merely being asked to follow the well-established principle of patent law of interpreting terms in claims 18-47 in light of the specification to decipher the meaning of the terms "advertising object" and "image object." There is absolutely no need for the applicants to amend the claim language as suggested by the examiner in the Examiner's Answer if the terms of claims 18-47 were interpreted correctly because the terms "advertising object" and "image object" are expressly defined in the specification as digital data structures that may be linked to one another.

Because the examiner has ignored some of the most fundamental principles of U.S. patent law, the examiner has completely ignored the context

within which the claim terms “advertising object” and “image object” are used in the instant application. The applicants completely disagree with the examiner’s assertion that “advertising object” and “image object” are merely perceivable or viewable video, graphical images, shapes or physical material. *See* Examiner’s Answer, page 16, lines 2-4. To the contrary, when construed in light of the specification, the terms “advertising object” and “image object” clearly refer to digital data structures that may be linked to one another and that may be used to generate video images. Again, while the advertising objects and image objects claimed in the instant application can be used to generate perceptible video images, that does not mean that the terms “advertising object” and “image object” are to be construed as such. *See* Brief on Appeal, page 11, lines 1-7.

Another fundamental principle of U.S. patent law states that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Accordingly, the inherent disclosure of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102. To rely upon the theory of inherency, however, the Board of Patent Appeals established that “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)
(emphasis in original); and MPEP 2112.

Again, the examiner has ignored this fundamental principle of U.S. patent law and has failed to interpret a word within its context. In particular, the examiner believes that the applicants are addressing a rejection under 35 U.S.C. 103(a) by the simple use of the word “obvious.” As stated in the Advisory Action, the examiner contends that “linking an advertisement object to an image object is a matter of design choice, design consideration, which does not directly impact the functionality of the system.” *See* Advisory Office Action (Paper No. 6), page 2, lines 13-14. To rebut this erroneous statement, the applicants merely stated Hite does not inherently disclose linkages between advertising objects and image objects and it would not have been an obvious matter of design choice to modify the system taught by Hite to include such linkages. Hite completely fails to disclose, either expressly or inherently, advertising objects and image objects as recited in the pending claims, much less linkages between advertising objects and image objects. Thus, persons of ordinary skill in the art would not have thought to re-design the system taught by Hite in such a way to link an advertising object to an image object because Hite does not teach or disclose digital data structures that may be linked to one another.

As a final matter, the applicants note that the examiner has incorrectly applied a line of cases including *In re Casey*, 152 USPQ 235 (C.C.P.A. 1967) and *In re Otto*, 136 USPQ 458 (C.C.P.A. 1963). *See* Examiner’s Answer,

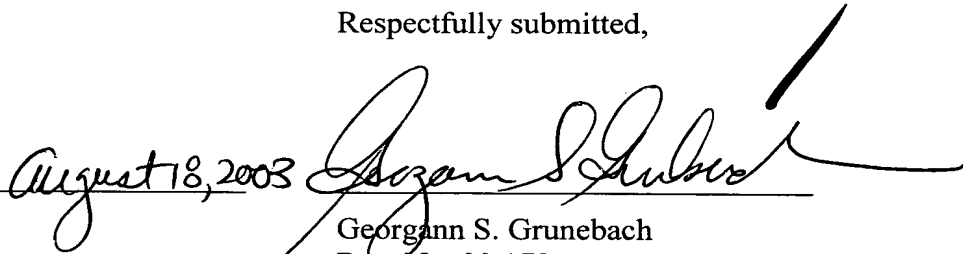
page 16, lines 8-11. This line of cases is limited to claims directed to machinery that works upon an article or material in its intended use. *See* MPEP 2115. In *Casey*, for example, the prior art device had the structure of the claimed device, and the difference was only in the use of the devices. Accordingly, the court held that the manner or method in which the device is to be used is not relevant to the issue of patentability of the device itself. In contrast, the system taught in Hite fails to teach or suggest structural elements of advertising objects and image objects as recited in pending claims 18-47. Because, the system taught in Hite and the claimed invention are structurally different, the line of cases referred to by the examiner is completely irrelevant.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that the rejections of claims 18-47 are based on legal and factual errors and that all of the pending claims should be allowed.

Respectfully submitted,

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